

## REMARKS

## Status of the Claims

Claims 1–27 remain pending in the application. Claims 2, 5, and 6 were previously presented. Claims 1, 14, and 27 have been amended to more clearly define the present invention, and Claim 14 has also been amended to correct a typographical error.

Claims Rejected under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 1-27 as being anticipated by Buxton et al. (U.S. Patent No. 6,469,714, hereinafter “Buxton”). The Examiner asserts that Buxton describes each element of applicants’ claimed invention. Applicants respectfully disagree with the rejection. Nevertheless, applicants have amended independent Claims 1, 14, and 27 to more clearly define the invention, as further discussed below. In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on amended independent Claims 1, 14, and 27. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants’ decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner’s conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants’ decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner’s interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. However, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

With regard to amended independent Claim 1, applicants have clarified their recited method for providing a selection of properties for an electronic document associated with an application program having a user interface to more clearly distinguish over Buxton's method. Significant differences exist between Claim 1 and Buxton, not only with regard to determination of context and status of a property for the electronic document, but also with regard to creation and display of a palette.

1       Applicants' recited claim language concerning the steps of determining the context and status  
2 of a property for the electronic document is neither implied nor suggested by Buxton. Applicants  
3 define "context" and "property" specifically and state that a palette is created based upon the data  
4 received in these *two* steps (see applicants' specification, page 13, line 7-10 ). For example, the  
5 property browser program processes information concerning a user's actions and determines a  
6 context that may be textual, formatting, or graphical. The property browser program also determines  
7 the status of a property that may be a command or feature of the application program (specification,  
8 page 12, line 28 - page 13, line 6 ).

9       The Examiner asserts that Buxton anticipates the step of determining context. The supporting  
10 citation referenced by the Examiner in Buxton, however, is unclear because it refers to a series of  
11 *four* steps, instead of referring to one step (Buxton, column 2, lines 61-67 ), and none of these steps  
12 really clearly teaches or suggests that Buxton is determining context in the manner claimed by  
13 applicants. Even assuming, *arguendo*, that the user interface description mentioned in the second of  
14 the four steps is Buxton's equivalent to applicants' step of determining context, "user interface  
15 description" remains an undefined term and is not clearly even related to the context of an electronic  
16 document property. This term as used in Buxton appears to derive from the querying that the  
17 InfoCenter performs on a Selection object when the InfoCenter hears about a SelectionContext.  
18 (Buxton, column 15, lines 18-23 ). SelectionContext is undefined, but a class of SelectionContext is  
19 referred to as something that allows the InfoCenter to receive various parameters (that remain  
20 undefined) for a selection assertion (Buxton, column 16, lines 56-58 ). Thus, there is no  
21 determination of a context as used by applicants' claimed method in Buxton's method. The  
22 Examiner also asserts that Buxton anticipates the step of determining the status of a property by  
23 reference to an Action Bar in Buxton that may show current status of an object (Buxton, column 7,  
24 lines 59-60 ). However, not only does Buxton's use of the word "may" imply that the status is  
25 indefinite and hence, sometimes unknown, but also this citation in Buxton points to the status of an  
26 object, not a property as defined in applicants' specification. Thus, the determination of the status of  
27 a property is not taught or suggested by Buxton.

28       Applicants' recited claim language concerning creation and display of a palette is also neither  
29 taught nor suggested by Buxton. First, as shown in FIGURE 5, applicants' method presents a palette  
30 and modified palette to the side of a document so that the palette does not obstruct the viewing of the

1 document and is modeless. "Modeless" means that the user is not required to make a selection before  
2 he or she can continue to interact with the document (see applicants' specification, page 2,  
3 lines 9-21). In contrast, as shown in FIGURE 3B, Buxton's method provides a pop-up menu that  
4 overlies and hence, obscures the document viewing space. In addition, Buxton admits that its user  
5 interface is not really modeless, since the user may have to respond to applet messages before the  
6 user can continue to interact with the document (Buxton, column 8 lines 15-19 ).

7 Second, the palette and modified palette are presented as part of a predefined interface, with  
8 consistent and coherent properties between each of the palettes and the predefined user interface,  
9 such as a toolbar (see applicants' specification, page 20, lines 9-18, and page 22, lines 25-33 ).  
10 Although Buxton aligns a dialog box with a predefined interface, unlike applicants' method, there is  
11 no suggestion in Buxton that the dialog box has its properties aligned with a toolbar for coordination  
12 and consistency, contrary to what the Examiner contends (Buxton, column 6, lines 43-58 ).

13 Third, applicants' palette and modified palette are completely customized; they are based on  
14 the context and the status of a property and include neither nonfunctional nor non-applicable items  
15 (see applicants' specification, page 19, lines 30–page 20, line 2, and page 22, lines 13-18 ). Although  
16 Buxton may discuss producing a customized graphic user interface based on a designer's input  
17 (Buxton, column 6, lines 56-57), it appears that this assertion is not true, based upon Buxton's  
18 reference to the Action Bar as providing access to the most common applet features of an applet  
19 (Buxton, column 7, lines 28-30 ). Use of an Action Bar having features that are common in usage  
20 instead of an Action Bar that includes features that are unique to a specific usage implies that Buxton  
21 does not create a truly customized user interface. Buxton's user interface is a partial customization at  
22 most. And instead of reconfiguring the Action Bar when a selection property changes, as does  
23 applicants' method, Buxton simply "dims" a feature on the Action Bar instead of removing it  
24 (Buxton, column 7 lines 60-64 ). A "dimmed" feature is neither a truly customized palette nor a  
25 modified customized palette, but simply a response to a condition in which a function cannot be  
26 implemented. Therefore, Buxton does not anticipate applicant's method of creating and displaying  
27 palettes.

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1       Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(e) over Buxton  
2 should be withdrawn for the reasons given above. Because dependent claims are considered to  
3 include all of the elements of the independent claims from which the dependent claims ultimately  
4 depend and because Buxton does not disclose or suggest all of the elements of independent Claim 1,  
5 the rejection of dependent Claims 2-13 under 35 U.S.C. § 102(e) over Buxton should be withdrawn  
6 for at least the same reasons as the rejection of Claim 1.

7       With regard to amended independent Claim 14, applicants have corrected a typo and provided  
8 further clarification that patentably distinguishes their method over Buxton's method. Claim 14 is  
9 directed to a computer system for providing a selection of formatting properties for an electronic  
10 document associated with an application program having a user interface. Clearly, for many of the  
11 reasons already noted, the amended claim distinguishes over Buxton. Applicant's claimed method,  
12 as shown in FIGURE 5, displays the palette without obscuring the electronic document. In contrast,  
13 as shown in FIGURE 3B of the cited art, Buxton's method provides a pop-up menu that overlies and  
14 hence, obscures the document viewing space. Accordingly, the rejection of independent Claim 14  
15 under 35 U.S.C. § 102(e) over Buxton should be withdrawn. Because dependent claims are  
16 considered to include all of the elements of the independent claims from which the dependent claims  
17 ultimately depend, and because Buxton does not disclose or suggest all of the elements of  
18 independent Claim 14, the rejection of dependent Claims 15-26 under 35 U.S.C. § 102(e) over  
19 Buxton should be withdrawn for at least the same reasons as the rejection of Claim 14.

20      With regard to amended independent Claim 27, applicants have clarified the system that is  
21 defined by the claim, so that it clearly implements functions different than those of Buxton's method,  
22 in regard to the display of the modified palette. This claim distinguishes over Buxton for reasons  
23 similar to those expressed above in connection with Claim 1. Accordingly, the rejection of  
24 independent Claim 27 under 35 U.S.C. § 102(e) over Buxton should be withdrawn.

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1 In view of the Amendment and the Remarks set forth above, it will be apparent that all claims  
2 in the application define a novel and nonobvious invention. Accordingly, this application should be  
3 passed to issue without further delay. Should any questions remain, the Examiner is asked to  
4 telephone applicants' attorney at the number listed below.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 23, 2004.

Date: February 23, 2004

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